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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/509,280	03/20/2000	PETER ROWAN KELLOCK	SPR6147P0010	3713

32116 7590 06/19/2007  
WOOD, PHILLIPS, KATZ, CLARK & MORTIMER  
500 W. MADISON STREET  
SUITE 3800  
CHICAGO, IL 60661

EXAMINER
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AN, SHAWN S

ART UNIT	PAPER NUMBER
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2621

MAIL DATE	DELIVERY MODE
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06/19/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/509,280

Applicant(s)

KELLOCK ET AL.

Examiner

Shawn S. An

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims pending in the application are 1-7,9,10,15,16,19,20,22,24-30,32,33,38,39,42,43,45,47-53,55,56,60-62,65,66,68 and 100-117.

Continuation of Disposition of Claims: Claims rejected are 1-7,9,10,15,16,19,20,22,24-30,32,33,38,39,42,43,45,47-53,55,56,60-62,65,66,68 and 100-117.

## **DETAILED ACTION**

### ***Reopen Prosecution***

1. In view of the Pre-Brief filed on 2/05/07, and the Pre-Brief appeal conference held with the supervisor, Mehrdad Dastouri, and the primary Examiner, Shawn An, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, Appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or
- (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then Appellant must pay the difference between the increased fees and the amount previously paid.

### ***Response to Statement for Pre-Appeal Brief***

2. Applicant's arguments with respect to currently pending claims have been carefully considered but not persuasive based on MPEP 2144.04.III.

Applicant's main argument is that Abecassis does not disclose any automatic process. However, MPEP 2144.04, III. Automating a Manual Activity clarifies that providing an automatic means to replace a manual activity, which accomplishes the same result, is not sufficient to distinguish over the prior art. Please refer to:

*In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

Therefore, the Examiner maintains the previous grounds of rejection as discussed in the last Office action as filed on 11/2/06.

Furthermore, a new grounds of rejection (101) concerning non-statutory basis with respect to claims 1-7, 9-10, 15-16, 19-20, 22, 47-53, 55-56, 60-62, 65-66, 68, 100-

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105, and 112-117 has been prepared. Please refer to the following new grounds of rejection for details. Moreover, the merits of these claims have been rejected and also have been discussed in the last Office action as filed on 11/2/06.

***Claim Rejections - 35 USC § 112***

3. Claim 61 recites the limitation "claim 57" in line 1. There is insufficient antecedent basis for this limitation in the claim, since the claim 57 has been canceled.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-7, 9-10, 15-16, 19-20, 22, 47-53, 55-56, 60-62, 65-66, 68, 100-105, and 112-117 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 47 and all of its dependent claims and claim 117 reciting a computer program product are considered non-statutory subject matter, since Applicant identifies the computer program product as a signal (Applicant; page 36, lines 5-11).

Claim 1 and all of its dependent claims and claim 105 reciting a system are considered non-statutory subject matter, since Applicant indicates the system described with reference to Figures 1 to 10 may be implemented as software, or a computer program, executing on the computer (Applicant; page 35, lines 7-9).

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1-2, 7, 9, 15-16, 19-20, 24-25, 30, 32, 38-39, 42-43, 47-48, 53, 55, 60-62, 65-66, 103-105, 109-111, and 115-117 are rejected under 35 U.S.C. 102(e) as being anticipated by Abecassis (6,067,401) as previously discussed in the last Office action as filed on 11/2/06.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3-6, 10, 22, 26-29, 33, 45, 49-52, 56, 68, 100-102, 106-108, and 112-114 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abecassis (6,067,401) as previously discussed in the last Office action as filed on 11/2/06.

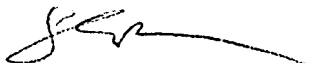
### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to *Shawn S. An* whose telephone number is 571-272-7324.

11. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**SHAWN AN**  
**PRIMARY EXAMINER**

6/09/07